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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/081,647	02/21/2002	Takashi Nozaki	B-4511 619552-8	1969
36716	7590	10/04/2005		
LADAS & PARRY 5670 WILSHIRE BOULEVARD, SUITE 2100 LOS ANGELES, CA 90036-5679			EXAMINER TAYLOR, NICHOLAS R	
			ART UNIT 2141	PAPER NUMBER

DATE MAILED: 10/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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## Office Action Summary

Application No.

10/081,647

Applicant(s)

NOZAKI ET AL.

Examiner

Nicholas R. Taylor

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. Claims 1-17 have been presented for examination and are rejected.

### ***Response to Arguments***

2. Applicant's arguments filed 8/1/2005 have been fully considered but they are deemed not persuasive.

3. In the remarks, applicant argued in substance that:

(A) The combination of Ukita and Murata is improper as Murata's personal information would not be useful in the system of Ukita.

As to point (A), in response to applicant's argument that Murata's positional information would defeat the intended use of Ukita, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In the instant case, Ukita teaches a system for combining advertisement information into email messages. To one of ordinary skill in the art, it is obvious that any type of information could be substituted for these advertisements; data such as

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server status information, corporate logos, user information, etc. could all be appropriate based on the circumstances and need. Murata goes further to explicitly suggest in the art the benefit of "improving the convenience and effectiveness" of sent email messages using the otherwise less useful positional information (Murata, paragraph 0009).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 2, 4-7, 9-13, and 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ukita et al. (US Patent 6,622,174) and Murata et al. (US PGPub 2001/0005854).

6. As per claim 1, Ukita teaches an electronic mail processing system that processes email messages sent via a network, said system comprising:

a plurality of terminals each provided with a function to send and receive the email messages through said network; (Ukita, column 4, lines 50-61)

a user information storage device for storing user information corresponding to registered users; (Ukita, column 9, lines 59-66)

an email adding device for referencing said user information storage device upon receipt of each of the email messages sent from said terminals, acquiring at least one

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predetermined item of information, and adding information to the email message; and (Ukita, column 11, lines 5-14)

an email forwarding device for forwarding the email message to which said predetermined item of said user information is added, to said terminals specified as recipients (Ukita, column 10, lines 18-28).

However, Ukita fails to teach wherein said information acquired for and added to the email message contains user information. Murata teaches an email adding device that references user information, specifically positional information, and adds this information to an email message (Murata, paragraph 0052-0054). It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have combined Ukita and Murata to provide the user information adding of Murata in the system of Ukita, because doing so would improve the convenience and effectiveness of positional data added to email (Murata, paragraph 0009).

7. As per claim 2, Ukita-Murata teaches the system further wherein said user information includes telephone number data, and wherein said email adding device adds the telephone number data to the email message (Murata, paragraph 0052, wherein the positional data includes telephone number data).

8. As per claim 4, Ukita-Murata teaches the system further wherein said user information includes position information, and wherein said email adding device adds the position information to the email message (Murata, paragraph 0052).

9. As per claim 5, Ukita-Murata teaches the system further wherein said user information includes position information and map link information corresponding to the position information, and wherein said email adding device adds the map link information to the email message (Murata, paragraph 0052 and 0062).

10. As per claim 6, Ukita-Murata teaches the system further wherein said plurality of terminals include terminals having an Internet access function and a display device, and wherein when said email forwarding device forwards the email message to which the map link information is added, the Internet access function allows map information to be acquired from an Internet site indicated by the map link information based on a predetermined operation, to display an image corresponding to the map information on said display device (Murata, paragraph 0062).

11. As per claim 7, Ukita-Murata teaches the system further wherein said plurality of terminals include portable terminals each provided with a function to send and receive the email messages by radiocommunication via base stations (Ukita, column 5, lines 47-54).

12. As per claim 9, Ukita teaches a mail server for processing email messages sent via a network to which a plurality of terminals are connected, said mail server comprising:

a user information storage device for storing user information corresponding to registered users; (Ukita, column 9, lines 59-66)

an email adding device for referencing said user information storage device upon receipt of each of the email messages sent from said terminals, acquiring at least one predetermined item of information, and adding said item of said information to the email message; and (Ukita, column 11, lines 5-14)

an email forwarding device for forwarding the email message to which said predetermined item of said user information is added, to said terminals specified as recipients (Ukita, column 10, lines 18-28).

However, Ukita fails to teach wherein said information acquired for and added to the email message contains user information corresponding to users using said terminals. Murata teaches an email adding device that references user information, specifically positional information, and adds this information to an email message (Murata, paragraph 0052-0054). It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have combined Ukita and Murata to provide the user information adding of Murata in the system of Ukita, because doing so would improve the convenience and effectiveness of positional data added to email (Murata, paragraph 0009).

13. As per claim 10, Ukita-Murata teaches the system further wherein said user information includes telephone number data, and wherein said email adding device

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adds the telephone number data to the email message (Murata, paragraph 0052, wherein the positional data includes telephone number data).

14. As per claim 11, Ukita-Murata teaches the system further wherein said user information includes position information, and wherein said email adding device adds the position information to the email message (Murata, paragraph 0052).

15. As per claim 12, Ukita-Murata teaches the system further wherein said user information includes position information and map link information corresponding to the position information, and wherein said email adding device adds the map link information to the email message (Murata, paragraph 0052 and 0062).

16. As per claims 13 and 15-17, Ukita-Murata teaches the system further wherein said plurality of terminals include portable terminals each provided with a function to send and receive the email messages by radiocommunication via base stations (Ukita, column 5, lines 47-54).

17. Claims 3, 8, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ukita et al. (US Patent 6,622,174) and Murata et al. (US PGPub 2001/0005854), further in view of Kamada et al. (US Patent 6,192,258).



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18. As per claim 3, Ukita-Murata teaches the above, yet fails to teach wherein said plurality of terminals include terminals having a telephone function by which a call operation is initiated to a link indicated by the telephone number data based on a predetermined operation.

Kamada teaches a function operable on a user terminal wherein a user can initiate a call operation through a link to telephone number data (Kamada, column 10, lines 42-47). It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have combined Ukita-Murata and Kamada to provide the telephone call link of Kamada in the system of Ukita-Murata, because doing so would enhance the operability of the user terminal (Kamada, column 2, lines 37-39).

19. As per claim 8, Ukita-Murata teaches the above, yet fails to teach wherein said portable terminals include portable terminals provided with a telephone function.

Kamada teaches a function operable on a portable user terminal wherein a user can initiate a call operation through a link to telephone number data (Kamada, column 10, lines 42-47). It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have combined Ukita-Murata and Kamada to provide the telephone call link of Kamada in the system of Ukita-Murata, because doing so would enhance the operability of the user terminal (Kamada, column 2, lines 37-39).

20. As per claim 14, Ukita-Murata-Kamada teaches the system further wherein said plurality of terminals include portable terminals each provided with a function to send

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and receive the email messages by radiocommunication via base stations (Ukita, column 5, lines 47-54).

### ***Conclusion***

21. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas Taylor whose telephone number is (571) 272-3889. The examiner can normally be reached on Monday-Friday, 8:00am to 5:30pm, with alternating Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on (571) 272-3880. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3718.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nicholas Taylor  
Examiner  
Art Unit 2141

  
RUPAL DHARIA  
SUPERVISORY PATENT EXAMINER